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10/622,146

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Tom McCarthy

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20306

7590

05/21/2010

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EXAMINER

SHEER, CRISTINA O

ART UNIT

PAPER NUMBER

3685

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/622,146

**Applicant(s)**

MCCARTHY ET AL.

**Examiner**

CRISTINA SHERR

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 and 46-83 is/are pending in the application.
- 4a) Of the above claim(s) 14-36, 41-44 and 46-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 27-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action is in response to Applicant's amendment filed February 11, 2010. Claims 1-44, and 46-83 are pending in this case. Claim 45 was previously canceled. Claims 14-36, 41-44, and 46-83 were previously withdrawn. Claims 1-13 and 37-40 are under examination. Claim 1 is currently amended.

***Response to Arguments***

2. Applicant's arguments, see Remarks, filed February 11, 2010, with respect to the section 112 rejection of claim 1, as currently amended, have been fully considered and are persuasive. The section 112 rejection of claim 1 has been withdrawn.

3. Applicant's arguments filed February 11, 2010 have been fully considered but they are not persuasive.

4. Applicant argues, regarding claim 1, as currently amended, that nothing in the cited prior teaches, discloses or suggests "a discovery service, provided on the first or second platform operable to search for stored media content and to download content based on a content profile."

5. Examiner respectfully disagrees. Attention is directed to Hendricks at col 9 In 66-62. Also, col 15 In 28-55 col 16 In 10-22, col 16 In 36-45.

***Official Notice***

6. Because Applicant did not traverse Examiner's assertion of Official Notice, the following is taken to be admitted prior art (MPEP 2144.02):

- that having a storage device comprising a hard disk drive is old and well-known.

- that the functions of a set top terminal are functions that old and well known to be performed by a personal computer.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-13 and 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al (US 5,659,350) in view of Gaske et al (EP 1 100 266 A2).

9. Regarding claim 1—

10. Hendricks discloses a system for rendering media content (e.g. abs) comprising:  
a first platform for storing media content, wherein the media content comprises an unrenderable (e.g. encrypted) state when received by the first platform (e.g. fig 3, 202 and 220; column/line 8/57-9/42; column 10, lines 36-40);  
a second platform communicatively coupled with the first platform for rendering the stored media content (e.g. fig 3, 222);  
a discovery service provided on the first or second platform operable to search for stored media content and to download content based on a content profile; (col 9 ln 66-62, col 15 ln 28-55 col 16 ln 10-22, col 16 ln 36-45.);  
the first and second platforms cooperatively providing an interface for purchasing a right to render the stored media content at least one time (e.g. fig 3, 900); and

at least one of the first platform and the second platform being operable to convert the stored media content to a renderable state upon the purchase of the right to render. (e.g. col 10 ln 57-67).

11. Hendricks does not disclose wherein the media content is stored at the subscriber location where it is later made renderable either through payment or other means. Gaske, however, does, at, e.g. fig 3 showing a set top box equipped for storing or caching encrypted programming for later playback. It would be obvious to one of ordinary skill in the art to combine the teachings of Hendricks and Gaske since both are in the field of rendering media content and in order to provide for local storage of media in the event of network failure while preserving security.

12. Hendricks discloses downloading content based on a content profile (e.g. col 16 ln 45-53). Gaske discloses searching downloaded and stored media content in order to decrypt and render content based on rights. (par 9, 61, 62, 63). It would be obvious to one of ordinary skill in the art to combine the teachings of Hendricks and Gaske since both are in the field of rendering media content and in order to provide for local storage of media in the event of network failure while preserving security, and also in order to playback media at any time rather than at scheduled intervals.

13. Regarding claim 2 –

14. Hendricks discloses the system of claim 1 further comprising: a distribution server connected to at least one of the first and second platforms and to at least one content source, the distribution server being operable to receive requests for content and to responsively retrieve content from the content sources (e.g. col 11 ln 20-45).

15. Regarding claim 3 –

16. Hendricks discloses the system of claim 1 further comprising: a distribution server connected to at least one of the first and second platforms and to at least one Content source (e.g. fig 2, 212), the distribution server being operable to track the usage of the content. (e.g. col 11 ln 47-55).

17. Regarding claim 4 –

18. Hendricks discloses the system of claim 1 further comprising: a distribution server connected to at least one of the first and second platforms and to at least one content source, the distribution server being operable to track the payment of the content. (e.g. col 11 ln 47-55).

19. Regarding claim 5 –

20. Hendricks discloses the system of claim 1 further comprising: distribution server connected to at least one of the first and second platforms and to at least one content source, the distribution server being operable to track the commerce of the content. (e.g. col 11 ln 47-55).

21. Regarding claim 6 –

22. Hendricks discloses the system of claim 1, wherein the first platform comprises a digital video recorder device that includes a storage device for storing the media content. (e.g. col 10 ln 57-67).

23. Regarding claim 7 –

24. Hendricks does not directly disclose a storage device specifically comprising a hard disk. Official Notice is taken that having a storage device comprising a hard disk

drive is old and well-known. Thus it would have been obvious to one of ordinary skill in the art to combine Hendricks with such a storage device given how common, economical, easy to find and use such hard disk drives are.

25. Regarding claim 8 –

26. Hendricks discloses as discussed above but Hendricks does not specifically disclose wherein the first platform comprises a personal computer that includes a storage device for storing the media content. However, Official Notice is taken that the functions of a set top terminal are functions that old and well known to be performed by a personal computer. Thus, it would be obvious to one of ordinary skill in the art at the time the invention was made to have a personal computer act as set-top terminal since this would make integral in one unit which might otherwise be done in two devices. Moreover, the resulting combination is predictable and would allow for recording of content on the computer.

27. Regarding claims 9-10 –

28. Hendricks does not specifically disclose the limitations of claims 9 and 10. However, Official Notice is taken that a storage device comprising an optical storage device, such as a digital versatile disk (DVD) drive is old and well-known. Thus it would have been obvious to one of ordinary skill in the art to combine Hendricks with such a storage device given how common, economical, easy to find and use such DVD's are.

29. Regarding claim 11 –

30. Hendricks discloses the system of claim 1, wherein the unrenderable state comprises a first level of encryption that protects the media content from unauthorized rendering. (e.g. col 11 ln 20-45).

31. Regarding claim 12 –

32. Hendricks discloses the system of claim 11, wherein the media content is contained in a broadcast signal and the unrenderable state comprises a second level of encryption that protects the media content from unauthorized reception and storage. (e.g. col 9 ln 18-40).

33. Regarding claim 13 –

34. Hendricks discloses the system of claim 12, wherein the broadcast is one of an over-the-air broadcast, a cable broadcast, an Internet broadcast and a satellite broadcast, and receiver therefor (e.g. col 1 ln 28-32).

35. Regarding claim 37 –

36. Hendricks discloses the system of claim 1, wherein the media content is stored on the first platform in a compressed format. (e.g. col 11 ln 20-45).

37. Regarding claims 38-39 –

38. Hendricks does not specifically disclose the various MPEG standards and layers thereof. However, Hendricks does contemplate using MPEG compressions standards generally. (e.g. col 6 ln 44-54, col 8 ln 23-38, col 9 ln 35-45, col 13 ln 56-61, col 14 ln 48-65). It would be a predictable result obvious to one of ordinary skill in the art at the time the invention was made to include various MPEG standards and layers thereof for



the compressed format. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

39. Regarding claim 40 –

40. Hendricks discloses the system of claim 1, wherein the first platform comprises: a digital video recorder having a storage device for retaining, at least a portion, of the media content; (e.g. col 11 ln 20-45).

a personal computer operatively coupled with the digital video recorder, wherein the personal computer provides (e.g. col 13 ln 37-46) for the purchase of the right to render the media content; management of rendering of the media content including: enforcing digital rights associated with the media content; and controlling rendering of the media content in correspondence with terms of the purchase. (e.g. col 15 ln 20-50)

### ***Conclusion***

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

42. "Computers and How They Work", by Roderick Hames, Copyright© 1998, Alton C. Crews Middle School: CS Dept – Articles  
(<http://www.crews.org/curriculum/ex/compsci/articles/howcomput.htm>).

43. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

44. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

46. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

47. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR  
Examiner  
Art Unit 3685

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685